

Attorney Docket No. AUS920000616US1  
Serial No. 09/710,927  
Response to Office Action dated 12/18/2003

## A. REMARKS

### 1. General Comments

The Examiner did not indicate whether the IDS filed on November 9, 2000 or the formal drawings filed on April 10, 2001 had been accepted. Please acknowledge whether the IDS and the formal drawings were accepted.

### 2. Claim Rejections – 35 USC § 102

The Examiner rejected claims 4, 7-10, and 14-16 under §102(b) as being anticipated by Kosaka et al. (JP 11250054, hereinafter Kosaka). The applicant asserts that Kosaka does not anticipate claims 4, 7-10, and 14-16 because Kosaka does not show every element of the claimed invention.

The requirements for anticipation under §102 are well established:

For a prior art reference to anticipate in terms of 35 USC § 102, every element of the claimed invention must be identically shown in a single reference. These elements must be arranged as in the claim under review. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990).

Kosaka fails to anticipate claims 4, 7-10, and 14-16 of the presently claimed invention because Kosaka fails to show all of the elements of the claimed invention in the order presented in the claims.

Kosaka discloses a method for creating a new webpage (See Kosaka, FIG. 7) by extracting elements from two existing webpages (See Kosaka, FIGS. 5 and 6). The method disclosed by Kosaka involves the division of each of the existing webpages into elements, called parts. Examples of the elements are graphics elements and table elements. Kosaka does not disclose the extraction of the entire existing webpages, but instead Kosaka discloses the

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extraction of specific elements from each of the webpages. Kosaka does not disclose any type of graphical user interface (GUI) to assist the user in creating the new webpage.

In contrast, the present invention discloses a multi-part GUI comprising a split screen work area and a split screen canvas. The split screen work area and the split screen canvas allow the user to see the existing webpages while the user is creating the new webpage. Thus, the user can view both the new and existing webpages simultaneously. Claims 4, 10, and 14 recite these limitations: "displaying a multi-part graphical user interface (GUI) comprising a split screen work area and a split screen canvas" and "wherein a user can simultaneously view the canvas web page and the first web page on the GUI." These claim limitations are not disclosed by Kosaka. Because the claims 4, 10, and 14 recite limitations not disclosed by Kosaka, Kosaka is an improper reference for a rejection under §102 and claims 4, 10, and 14 should be allowed. In addition, claims 7-9, 15, and 16 should be allowed because they depend on allowable independent claims.

### 3. Claim Rejections – 35 USC §103

The Examiner rejected claims 1-3, 5, 6, and 11-13 under §103(a) as being unpatentable over Kosaka in view of Straznitskas ("Mastering Photoshop 5 for the Web," hereinafter Straznitskas). The Applicant asserts that the obviousness rejection is improper because the Examiner has not established a *prima facie* case of obviousness.

The requirements for a *prima facie* case of obviousness are well defined:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

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references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. MPEP §706.02(j) citing *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis ours).

Similarly, the fact that the Examiner has the burden of proof with respect to the elements of the *prima facie* case of obviousness is also well defined:

To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998).

With respect to claims 1-3, 5, 6, and 11-13, the Examiner has not met his burden of presenting the *prima facie* case with respect to the third prong of the obviousness test.

Claim 1 recites the limitations "rendering said first web page remainder transparent; wherein the first web page is layered with a second web page comprising a second information unit and a second web page remainder." Straznitskas does not teach or suggest either of these claim limitations nor does the Examiner rely on Straznitskas in his rejection of the cited section of claim 1. Thus, in order to make out a *prima facie* case of obviousness, Kosaka must teach or suggest the rendering of the first web page remainder transparent and layering of the first webpage with the second webpage.

The Examiner takes the position that Kosaka page 13, paragraphs 2, 3, and 4 teaches the limitation "rendering said first web page remainder transparent." Kosaka does not render any portion of the existing webpages transparent. Instead, Kosaka divides each of the existing webpages into elements (See Kosaka, page 13, paragraph 2). Kosaka then extracts the desired elements and combines the extracted elements to create the new webpage (See Kosaka, page 13,

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paragraph 4). Thus, Kosaka does not teach or suggest the limitation "rendering said first web page remainder transparent."

The Examiner takes the position that Kosaka, FIG. 6, item c, and FIG. 7, item c, teaches the claim limitation "wherein the first web page is layered with a second web page comprising a second information unit and a second web page remainder." In Kosaka, FIG. 6 is an existing webpage and FIG. 7 is the new webpage. Kosaka does not teach or suggest the layering of two existing webpages to create a new webpage. Instead, Kosaka discloses the creation of the new webpage by extracting specific elements from each of the two webpages (See Kosaka, pages 12-13). Thus, Kosaka does not teach or suggest the limitation "wherein the first web page is layered with a second web page comprising a second information unit and a second web page remainder."

Claim 13 recites the limitation "displaying a multi-part graphical user interface (GUI) comprising a split screen work area and a split screen canvas." Kosaka does not disclose any GUIs to assist the user in creating the new webpage from the existing webpages. Thus, Kosaka does not teach or suggest a multi-part GUI comprising a split screen work area and a split screen canvas.

As previously stated, in order to establish a *prima facie* case of obviousness, the references must teach or suggest every claim limitation. Kosaka does not teach or suggest the rendering of a first web page remainder transparent. Kosaka also does not teach or suggest the layering of two webpages to create a third webpage. Kosaka also does not teach or suggest a multi-part GUI comprising a split screen work area and a split screen canvas. Because the prior art does not teach or suggest all of the claimed limitations, the Examiner has not established a

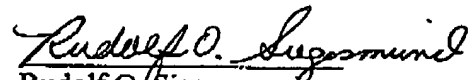
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*prima facie* case of obviousness under §103(a) and claims 1 and 13 should be allowed. Claims 2, 3, 5, 6, 11, and 12 should be allowed because they depend on allowable independent claims.

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For the foregoing reasons, the Applicant submits that the claims of the present application are not fairly taught by any of the references of record, taken either alone or in combination. Therefore, allowance of the present application is in order, and is requested.

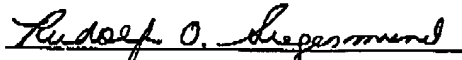
Respectfully submitted,

  
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